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OFFICE OF PETITIONS

In re Application of
Caplan, et al.
Application No.: 10/697,907
Filed: October 29, 2003
Attorney Docket No.: ISAA0025
For: METHOD AND APPARATUS FOR
CREATING AND EVALUATING STRATEGIES :

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the second reconsideration petition under 37 CFR 1.47(a), filed December 15, 2004.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on October 29, 2003 without an executed oath or declaration. Accordingly, on January 30, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for their late filing.

In response, on April 30, 2004, a petition for a one month extension of time and required fee, a declaration executed by 11 of 15 joint inventors, the surcharge, the petition fee, and the instant petition were filed. A statement of facts by Rhonda Dunn, the patent administrator for the non-signers' former employee, accompanies the petition. Ms. Dunn explains that non-signing joint inventor Gary Sullivan received multiple copies of the above-identified application and declaration for the above-identified application, but he did not respond to the many requests that he sign the declaration for patent application. The statement of facts of Attorney Michael A. Glenn and accompanying exhibits establish that the three other non-signing inventors, John Perlis, Nina Shikaloff, and Aush Thaker, refused to review the declaration and application papers, let alone sign the declaration, unless certain demands were met. Their attorney, William M. Scherer, returned the unread application papers and declaration on his clients' behalf. The evidence presented shows that the inventors were given the opportunity to review the application papers, but declined to do so. They have constructively refused to join in the filing of the application.

Applicants' petition was dismissed on June 22, 2004 because the declaration did not contain identifying information for all inventors and a complete statement of the last known address for the non-signing inventors was not provided.

A reconsideration petition was timely filed on August 23, 2004. The reconsideration petition was

dismissed on September 22, 2004 for failure to submit an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 and failure to present the last known address for Inventor Perlis.

The instant petition and a request for a one month extension of time and required fee was filed on December 15, 2004.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (4) the last known address of the omitted inventor(s).

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration is not acceptable for two reasons.

First, petitioners have not submitted a new declaration which contains the signatures of the fifth named inventor, Brendan Del Favero, and the seventh named inventor, Robert Mun-Cheong Fung. Their respective signature blocks are blank on all copies of the new declaration submitted with the second reconsideration petition.

Second, the ninth named inventor, Jun Hua, has altered his information without initialing and dating the changes. 37 CFR 1.52(c) states that "[a]ny interlineation, erasure, cancellation or other alteration of the application papers filed should be made on or before the signing of the accompanying oath or declaration pursuant to 1.63...." This includes the oath or declaration. The Office will not consider whether noninitialed and or nondated alterations were made before or after signing of the oath or declaration but will require a new oath or declaration. See MPEP 605.04(a).

Fortunately, the deficiencies or inaccuracies relate to a signing inventor. Thus, pursuant to 37 CFR 1.67(a)(2), Mr. Hua can correct/clarify his respective information on a supplemental declaration identifying the entire inventive and their information, but entity but signed only by him.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
220 20th Street S.
Customer Window, Mail Stop Petition
Crystal Plaza 2, Lobby, Room 1B03
Arlington, VA 22202

By FAX: (703) 872-9306 – ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.

A handwritten signature in black ink, appearing to read "E. Shirene Willis". The signature is fluid and cursive, with a large initial "E" and a stylized "W".

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy